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Geetha Ravishankar

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LEON R TURKEVICH

2000 M STREET NW

7TH FLOOR

WASHINGTON, DC 200363307

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEETHA RAVISHANKAR, SATISH JOSHI,
NAGENDRAN PARASU, and ZHIWEI ZHANG

Appeal 2008-2729
Application 09/820,884
Technology Center 2100

Decided:¹ March 10, 2009

Before LANCE LEONARD BARRY, JAY P. LUCAS, and
THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

Appellants appeal from the Examiner's final rejection of claims 1-21, 23-31, and 34-43 under 35 U.S.C. § 134 (2002). Claims 22, 32, and 33 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b)(2002).

A. INVENTION

According to Appellants, the invention relates to an application server configured for initiating a messaging session for an incoming call by accessing a subscriber profile information from a directory server and a subscriber announcement from a messaging server (Spec., Abstract).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. A method in a server configured for initiating a messaging session for an incoming call by accessing subscriber profile information from a directory server, the method comprising:

attempting retrieval of a subscriber announcement for the messaging session from a messaging server based on the subscriber profile information, the subscriber announcement stored in the messaging server as a first data file having a first size;

determining an inaccessibility of the subscriber announcement for the messaging session from the messaging server;

retrieving from the directory server an audible subscriber identifier, stored in the directory server as a second data file having a second size

substantially smaller than the first size, based on the determined inaccessibility of the subscriber announcement; and

playing for the messaging session an alternate subscriber announcement including the audible subscriber identifier.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

| | | |
|----------|-----------------|---------------|
| Edmonds | US 6,230,190 B1 | May 8, 2001 |
| Kruesi | US 6,504,915 B1 | Jan. 7, 2003 |
| Fuller | US 6,545,589 B1 | Apr. 8, 2003 |
| Bates | US 6,631,181 B1 | Oct. 7, 2003 |
| Gebhardt | US 6,769,027 B1 | Jul. 27, 2004 |

Claims 1, 11, 12, 18, 19, 29, 30, and 40-43 stand rejected under 35 U.S.C. § 103(a) over the teachings of Bates, in view of Fuller and Kruesi.

Claims 2-6, 8, 13-16, 20, 21, 23, 24, 26, 31, 34, 35, and 37 stand rejected under 35 U.S.C. § 103(a) over the teachings of Bates, in view of Fuller, Kruesi, and Edmonds.

Claims 7, 25, and 36 stand rejected under 35 U.S.C. § 103(a) over the teachings of Bates, in view of Fuller, Kruesi, Edmonds, and Official Notice.

Claims 9, 10, 17, 27, 28, 38, and 39 stand rejected under 35 U.S.C. § 103(a) over the teachings of Bates, in view of Fuller, Kruesi, and Gebhardt.

We reverse.

II. ISSUES

Have Appellants shown that the Examiner erred in finding that the combined teaching of Bates, Fuller, and Kruesi discloses “retrieving from the directory server an audible subscriber identifier, stored in the directory server as a second data file having a second size substantially smaller than the first size, based on the determined inaccessibility of the subscriber announcement (stored in the messaging server)” (Claim 1).

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Bates

1. Bates discloses identifying a unique caller from an incoming call transmission at a messaging system, and playing a particular greeting announcement to the unique caller from among multiple greeting announcements recorded at the messaging system, wherein the particular greeting announcement was previously specified by a subscriber of the messaging system for the unique caller (Abstract).
2. The caller ID is captured for the incoming call transmission, the captured caller ID is compared with the caller ID pre-recorded greeting designations for the subscriber, and a determination is made

as to whether or not a pre-recorded greeting is designated for the caller ID (col. 7, ll. 8-14).

Fuller

3. Fuller discloses determining if a standard greeting type is “drop-in”, wherein the subscriber’s prerecorded drop-in name is retrieved and the call processor plays the greeting and completes the greeting by playing back the pre-recorded name of the subscriber (col. 25, l. 59 to col. 26, l. 2).
4. If the standard greeting type was found not to be “drop-in,” then a check is made to determine if the standard greeting type is “personalized,” where the subscriber’s pre-recorded personalized greeting is retrieved and is then played back to the caller (col. 26, ll. 4-12).

Kruesi

5. Kruesi discloses system “availability” of a messaging system, wherein the messaging system can be highly reliable and able to quickly recover from system failures (col. 3, ll. 1-4).
6. In a “failure mode,” when one of the nodes has failed, the other node is given read/write access to its voice file (col. 9, ll. 63-66).

IV. PRINCIPLES OF LAW

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If the Examiner’s burden is met, the burden then shifts to the Appellant to overcome the *prima facie* case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See id.*

V. ANALYSIS

35 U.S.C. § 103(a)

Claims 1, 11, 12, 18, 19, 29, 30, and 40-43

Bates discloses playing a particular greeting announcement recorded at the messaging system (FF 1), based on the caller ID pre-recorded greeting designations for the subscriber (FF 2). We find an artisan would have understood the step of playing the greeting announcement to be a step of attempting retrieval of a subscriber announcement as recited in claim 1.

Fuller discloses alternatively playing a standard greeting and completing the greeting by playing back the pre-recorded “drop-in” name of the subscriber (FF 3), or the subscriber’s pre-recorded personalized greeting (FF 4). We find an artisan would have understood the personalized greeting to be a subscriber announcement, and the standard greeting including the drop-in name to be an alternate subscriber announcement including the audible subscriber identifier as recited in claim 1. That is, we find the recorded drop-in name to be the audible subscriber identifier.

Furthermore, Kruesi discloses determining the “availability” of a messaging system (FF 5), wherein a data file is retrieved on a second server/node when a first server/node is in failure mode, ie., not available (FF 6). We find an artisan would have understood that the combination of Bates, Fuller and Kruesi teaches and strongly suggests the steps of attempting retrieval of a subscriber announcement, determining the availability of a messaging system, and retrieving a file from a second server when the first server is in failure mode.

Though Appellants argue that none of the applied references discloses or suggests a server determining an inaccessibility of a subscriber announcement that is stored in a messaging server (App. Br. 10), we find that the combination of Bates, Fuller, and Kruesi teaches and suggests such feature. In particular, Bates discloses playing a subscriber announcement stored in the messaging system (FF 1), and Kruesi discloses determining the accessibility (availability) of the messaging system (FF 5).

Similarly, though Appellants argue that the hypothetical combination of the applied references does not disclose or suggest retrieving an alternate subscriber announcement (App. Br. 18), we find that the combination of Bates, Fuller, and Kruesi teaches and suggests such feature. In particular, we find the recorded drop-in name of Fuller to be an audible subscriber identifier (FF 1), wherein the alternatively used standard greeting including the drop-in name is an alternate subscriber announcement that includes the audible subscriber identifier.

The Appellants further contend that the rejection fails to demonstrate that one of ordinary skill in the art would have been motivated to combine the teachings of Bates, Fuller, and Kruesi (App. Br. 17). To address the issue of whether it would have been obvious to combine the teachings of Bates, Fuller, and Kruesi, we must determine whether or not the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). Obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case, and the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not. *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007). That is, the test for obviousness is rather what the combined teachings of the references

would have suggested to those of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991).

Bates, Fuller, and Kruesi are all directed to a messaging system. We find that combining the teachings “for improved file availability” as found by the Examiner (Ans. 15) would require no more than "ordinary skill and common sense" (*KSR*, 127 S. Ct. at 1742). Appellants have presented no evidence that combined the teachings of messaging systems "was uniquely challenging or difficult for one of ordinary skill in the art," nor have Appellants presented evidence that this "represented an unobvious step over the prior art." *See Leapfrog*, 485 F.3d at 1162.

A person of ordinary skill will be able to fit the teachings of Bates, Fuller, and Kruesi together like pieces of a puzzle since the “person of ordinary skill is also a person of ordinary creativity, not an automaton.” *See KSR*, 127 S. Ct. at 1742. The person of ordinary skill and common sense would find it obvious to combine the teachings “for improved file availability” as found by the Examiner (Ans. 15). Appellants have not presented any evidence to indicate why it would not have been obvious to combine the references.

However, Appellants also contend that

each of the independent claims explicitly specify that: (1) the subscriber announcement is stored in the messaging server; (2) the audible subscriber identifier is stored in the directory server; and (3) the audible subscriber identifier is retrieved from the *directory server* based on the determined *inaccessibility* of the stored subscriber

announcement from the *messaging server*, for playback of an *alternate* subscriber announcement including the audible subscriber identifier.

(App. Br. 10-11). Appellants further contend that “the claimed *server* retrieves the audible subscriber identifier from a distinct server based on the inaccessibility of the subscriber announcement from another distinct server” (*id.* at 11). The Examiner finds that the combination of Bates, Fuller, and Kruesi discloses such teaching (Ans. 3-6). Accordingly, an issue we address on appeal is whether the combined teaching of Bates, Fuller, and Kruesi teaches or would have suggested “retrieving from the directory server an audible subscriber identifier, stored in the directory server as a second data file having a second size substantially smaller than the first size, based on the determined inaccessibility of the subscriber announcement” (Claim 1).

After reviewing the record on appeal, we agree with Appellants. While the combination of Bates, Fuller, and Kruesi teaches or at the least suggests the steps of attempting retrieval of a subscriber announcement, determining the availability of a messaging system, and retrieving a file from a second server when the first server is in failure mode (FF 1-6), we agree with the Appellants that the audible subscriber identifier is not retrieved from a directory server based on the determined inaccessibility of the subscriber announcement (stored in the messaging server), as required by claim 1. That is, there is no teaching or even a suggestion in any of the references of retrieving an audible subscriber identifier from a second (directory) server when the first (messaging) server is determined to be

inaccessible. In fact, Kruesi discloses retrieving the *same* data file from a second server/node when a first server/node is in failure mode (FF 6), and thus, does not teach retrieving any audible subscriber identifier to provide an alternate announcement.

As such, we will reverse the rejection of representative claim 1 and claims 11, 12, 18, 19, 29, 30, and 40-43 standing therewith over Bates, Fuller, and Kruesi. We thus conclude that Appellants have shown that the Examiner erred in rejecting claims 1, 11, 12, 18, 19, 29, 30, and 40-43 under 35 U.S.C. § 103(a) for the reasons as set forth above.

For similar reasons, we will reverse the rejections of: 1) claims 2-6, 8, 13-16, 20, 21, 23, 24, 26, 31, 34, 35, and 37 over Bates, Fuller, Kruesi, and Edmonds; 2) claims 7, 25, and 36 over Bates, in view of Fuller, Kruesi, Edmonds, and Official Notice; and 3) claims 9, 10, 17, 27, 28, 38, and 39 over Bates, in view of Fuller, Kruesi, and Gebhardt .

VII. CONCLUSIONS OF LAW

A. Appellants have shown that the Examiner erred in finding claims 1, 11, 12, 18, 19, 29, 30, and 40-43 unpatentable under 35 U.S.C. § 103(a) over the teachings of Bates, Fuller, and Kruesi.

B. Appellants have shown that the Examiner erred in finding claims 2-6, 8, 13-16, 20, 21, 23, 24, 26, 31, 34, 35, and 37 unpatentable under 35 U.S.C. § 103(a) over the teachings of Bates, Fuller, Kruesi, and Edmonds.

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C. Appellants have shown that the Examiner erred in finding that claims 7, 25, and 36 unpatentable under 35 U.S.C. § 103(a) over the teachings of Bates, Fuller, Kruesi, Edmonds, and Official Notice.

D. Appellants have shown that the Examiner erred in finding that claims 9, 10, 17, 27, 28, 38, and 39 unpatentable under 35 U.S.C. § 103(a) over the teachings of Bates, Fuller, Kruesi, and Gebhardt.

VIII. DECISION

We have not sustained the Examiner's rejections with respect to any claim on appeal. Therefore, the Examiner's decisions rejecting claim 1-21, 23-31, and 34-43 are reversed.

REVERSED

msc

LEON R TURKEVICH
2000 M STREET NW
7TH FLOOR
WASHINGTON DC 20036-3307